

REMARKS

I. Claim Amendments

Claims 1, 28 and 32 are canceled herein.

Claims 2-11 are amended to recite a method instead of an agent and to depend from method claim 31.

Claims 2-4 and 31 and withdrawn claim 29 are amended by deleting the phrase “or a prodrug thereof”.

Withdrawn claim 30 is amended to recite that the drug according to claim 29 is a pharmaceutical composition.

Various other minor amendments are made to correct informalities. No new matter is presented.

Upon entry of the Amendment, claims 2-27 and 29-31 will be all of the claims pending.

II. Election of Species

The Examiner has acknowledged Applicants’ election of the compound of Example 50 in the Reply filed on December 19, 2007. The Examiner further states that the search was expanded and claims 2-32 are withdrawn from consideration because, according to the Examiner, other art was found.

As noted above, claim 1 is canceled and claims 2-11 are amended to recite a method and to depend from claim 31. Claims 2-3, 5-13, 15-23 and 25-27 and 29-31 read on the elected species of the compound of Example 50. Applicants submit that since claim 31 is a method claim and reads on the elected species, claim 31 should not have been withdrawn and therefore is identified as an “original” claim. Compound claims 12-27 and 29-30 are indicated as

“withdrawn” in view of the Examiner’s determination of the subject matter for examination as indicated in the Office Action dated January 23, 2008. However, if claim 31 is found allowable, claims 2-11 which are amended to depend from method claim 31 should also be allowed.

III. Response to Claim Rejections under 35 U.S.C. § 112

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner objects to the terms “substituted”, “heterocyclic” and “prodrug” as stated at page 3 of the Action.

Applicants respectfully traverse the rejection as to the terms “substituted” and “heterocyclic” and submit that these terms are definite. The Examiner’s focus in determining whether the claims are definite in compliance with 35 U.S.C. § 112, second paragraph should be whether the claims set out the claimed subject matter with a reasonable degree of clarity and particularity in light of (1) the content of the specification; (2) the teachings of the prior art; and (3) the claim interpretation that would be given by one of ordinary skill in the art. In this case, the term “substituted” is a term commonly used in the art and the specification provides definitions and examples of the substituents that may be employed. See, for example, pages 36-37 and 49-50. Similarly, the term “heterocyclic” is commonly used in the art and the specification provides definitions and examples of heterocyclic groups of the present invention. See, for example, page 46. Therefore, when properly read in light of the specification and in view of the teachings in the art, one of ordinary skill in the art would have readily been able to ascertain the meaning and scope of the claim language.

The claims are amended herein by deleting reference to a “prodrug”, thereby obviating this ground for rejection.

Accordingly, Applicants respectfully request withdrawal of the §112, second paragraph rejections.

IV. Response to Claim Rejection under 35 U.S.C. § 102

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Yukimasa et al (WO 97/10224) (hereinafter “WO ‘224”).

Without conceding the merits of the rejection, claim 1 is canceled herein, thereby rendering the rejection moot.

Accordingly, Applicants respectfully request withdrawal of the §102 rejection.

V. Response to Claim Rejection under 35 U.S.C. § 103

The Office Action indicated that claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Yukimasa et al (WO 97/10224) (“WO ‘224”).

Without conceding the merits of the rejection, claim 1 is canceled herein, thereby rendering the rejection moot.

Accordingly, Applicants respectfully request withdrawal of the §103 rejection.

VI. The Presently Claimed Invention

Independent claim 31 recites a method for modulating the function of an RFRP receptor, which comprises administering an effective amount of a compound represented by formula (I) to a mammal. The cited reference, WO ‘224 does not disclose, teach or suggest the presently

claimed method. Thus, the presently claimed invention is not anticipated nor rendered obvious by WO '224.

Additionally, the compounds used in the presently claimed method are taught to have unexpectedly excellent RFRP receptor antagonism based on its particular structure, whereas, the compounds disclosed by WO '224 are described as having cholesterol and triglyceride lowering activities and being useful for the prophylaxis and therapy of hyperlipidemia. There is no description of the compounds of WO '224 having RFRP receptor antagonism activity or being useful for the diseases and conditions recited in the present claims. Thus, one of ordinary skill in the art would not have had a reasonable expectation of success of achieving the presently claimed invention, i.e., a method of modulating the function of an RFRP receptor based on the disclosure of WO '224. For at least this reason independent claim 31 is not anticipated nor rendered obvious over by WO '224. Claims 2-11, which depend from claim 31 are patentable for at least the same reasons.

Further, Applicants submit that the compounds of withdrawn claims 12-27 are completely different from those of WO '224 and therefore these claims should be examined in accordance with MPEP §803.02.

VII. Conclusion

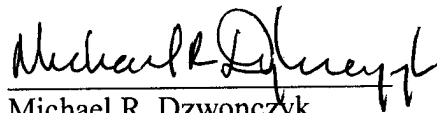
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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